



UNITED STATES DEPARTMENT OF COMMERCE  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/689,518	08/09/96	HOUSE	J 4100-4103-1

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D3M1/0303

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ART UNIT	PAPER NUMBER
1314	10

03/03/98  
DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<b>Office Action Summary</b>	Application No. <b>08/689,518</b>	Applicant(s) <b>House</b>
	Examiner <b>Jenna Davis</b>	Group Art Unit <b>1314</b>

Responsive to communication(s) filed on 12/2/97.

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 26-41 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 26-41 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

- Notice of References Cited, PTO-892
- Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- Interview Summary, PTO-413
- Notice of Draftsperson's Patent Drawing Review, PTO-948
- Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and © may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 26 to 41 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 5,511,897.

7. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in the present application are broad enough to encompass the method and kit claimed in the '897 patent.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 26 to 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arntyir in view of Nimke.

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Arntyteaches a method and device for sealing conduits such as manholes wherein a elastomeric band is placed about the conduit to seal it. Arntyte does not provide an adhesive on the interior of his band to secure it to the conduit. As shown by Nimke, the art of sealing conduits of this type had known that providing an adhesive on the inner surface of a sealing band allowed the band to securely seal an underlying conduit. Thus, to have provided the Arntyte bands with an adhesive in order to obtain a secure seal would have been obvious to a person having ordinary skill in the art.

4. Applicant's arguments filed December 2, 1997, have been fully considered but they are not persuasive.

The Examiner acknowledges that Arntyte uses a metal band to secure the elastomeric sleeve to a manhole riser. However, Nimke, not Arntyte has been relied upon to show that the art of sealing conduits knew that adhesive was useful to attach such covers to underlying materials in order to provide secure seals.

The argument regarding the necessity of even heating required by Nimke is not persuasive because it is not commensurate in scope with the claims. The present claims are not limited to any particular type of adhesive and would include a heat activated adhesive of the type taught by Nimke.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry regarding this communication or earlier communications from the Examiner should be directed to Jenna Davis, whose telephone number is (703) 308-2429. The Examiner can normally be reached Monday to Friday from 9:30 AM to 6:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Marion McCamish, can be reached on (703) 308-3961. A facsimile center has been established in Group 1300, Crystal Plaza 3, 8th floor. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier number for accessing the facsimile machine is (703) 305-7718. This location should be used in all instances when faxing any correspondence to Art Unit 1314. Use of the Group 1300 center will facilitate rapid delivery of materials to Examiners in Art Unit 1314.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-2351.

*Jenna Davis*  
**Jenna Davis**  
**Primary Examiner**  
**Group 1300**

jd  
8/29/97